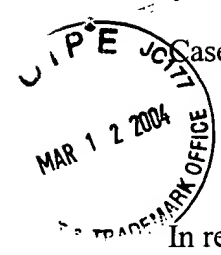


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P. Nelson
03/20/04



Case Docket No.: SN-US000610

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:

Yasushi NISHIMURA

Serial No.: 09/986,977

Filed: November 13, 2001

For: PAINT-COATED COMPONENTS

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Appeal No.: _____
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Group Art Unit: 3654
:
Examiner: Evan H. Langdon
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BRIEF ON APPEAL

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GROUP 3600

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Commissioner of Patents
United States Patent and Trademark Office
Washington, D.C. 20231

Sir:

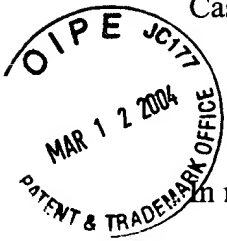
For the appeal to the Board of Patent Appeals and Interferences from the Examiner's decision dated October 16, 2003 finally rejecting claims 15-20, Applicant-Appellant submits the following brief in accordance with 37 C.F.R. §1.192 (a).

1. Real Party In Interest

Shimano, Inc. is the owner in the above-identified patent application. Thus, the real party in interest is Shimano, Inc.

2. Related Appeals and Interferences

Appellant and Appellant's legal representatives are not aware of any appeals or interferences relating to the above-identified patent application.



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3. Status of Claims

On January 15, 2003, Appellant appealed from the final rejection of claims 15-20, claims 1-14 having been canceled in the Amendment filed on September 12, 2003.

4. Status of Amendments

Claims 15-20 of the present application have not been amended during the course of prosecution, and are not amended by this appeal.

5. Summary of the Invention

Appellant's invention on appeal concerns a fishing reel having a metal film layer that provides a mirroring effect. The fishing reel (claims 15-20) has a reel body 1 or 102, a handle assembly 2 or 101 disposed on a side of the reel body 1 or 102, and a line-winding spool 4 or 104 removably and reattachably fitted to the reel body 1 or 102 as seen in Figures 1-2 and 4. The reel body 1 or 102 has a component body, a ground film-layer formed by a paint coat on an obverse layer side of the component body, and metal film means or metal film layer 13 for providing a mirroring effect as seen in Figure 3. The metal film means is formed semi transparently on an obverse layer side of the ground film layer 12.

In the main embodiments of the present application, the metal film means is the metal film layer 13 that is formed by sputtering aluminum and adjusting the film thickness with a half-transparency (page 5, lines 18-20, page 6, lines 10-12 of the specification). The semi transparent mirroring effect can be obtained by varying the thickness of the metal film layer (page 6, lines 13-17) as well as the proportion of masked portion in the ground coating 12 between 80% and

5% (page 6, lines 11-12). A semi transparent mirroring surface is defined in this application as a surface that has a mirroring effect while the pattern on the ground coating can be seen underneath (page 6, lines 17-19).

Although the metal film means of the main embodiment of the present application is formed by sputtering of aluminum, the metal film layer may be formed by other metal-vapor deposition methods such as ionic plating (page 8, lines 10-11). Furthermore, metals other than aluminum, such as chrome, nickel, zinc, magnesium, stainless steel alloys, and titanium may be utilized to form the metal film layer (page 8, lines 15-18).

Furthermore, although the thickness of the metal film layer 13 is indicated as between 600-50 angstroms (\AA) in the main embodiment (page 6, line 16), the thickness of the metal film layer is not limited thereto. More specifically, the specification clearly indicates that the thickness by which a mirroring effect is yielded varies depending on the type of paint in the ground coating, the type of target metal, and the coarseness of the metal powder (page 6, lines 22-30). Thus, the thickness of the metal film layer is not limited to 600-50 \AA . Instead, the metal film may be formed in any thickness without deviating from the scope of the claims, as long as the metal film layer is semi transparent and renders the mirroring effect.

6. *Issues*

Claims 15-20 stand finally rejected in view of prior art. Specifically, claims 15, 17-20 stand rejected under §103 (a) as being unpatentable over Japanese Patent Application Publication 2001-017040 to Nanbu Kazuya ("Nanbu patent") in view of U.S. Patent No. 4,369,225 to Manabe et al. ("Manabe patent"), and claims 15-16 stand rejected under §103 (a) as being

unpatentable over Japanese Patent Application Publication 11-206284 to Koike Mamoru (“Koike patent”) in view of the Manabe patent.

The following issues are presented for review:

- (A) Whether claims 15, 17-20 are unpatentable over Japanese Patent Application Publication 2001-017040 to Nanbu Kazuya in view of U.S. Patent No. 4,369,225 to Manabe et al. under 35 U.S.C. §103.
- (B) Whether claims 15-16 are unpatentable over Japanese Patent Application Publication 11-206284 to Koike Mamoru in view of U.S. Patent No. 4,369,225 to Manabe et al. under 35 U.S.C. §103.

7. Grouping of Claims

Claims 15-18 stand and fall together. Claims 19-20, however, do not stand or fall together. The reason why Appellant believes these claims to be separately patentable are explained below in the Argument.

8. Arguments

The Office Action of October 16, 2003 asserts that claims 15 and 17-20 are rendered obvious by the Nanbu patent and the Manabe patent, because the Nanbu patent shows a fishing reel of claim 15 (double bearing reel) except for the metal film layer providing a mirror effect, and the Manabe patent shows a metal layer providing a mirror effect as set forth in column 3,

lines 14-24, 30-43, 67-68, in column 4, lines 1-3, and in column 5, lines 1-12. The Office Action also asserts that claims 15 and 16 are rendered obvious by the Koike patent and the Manabe patent, because the Koike patent shows a fishing reel of claim 15 (spinning reel) except for the metal film layer providing a mirror effect, and the Manabe patent shows a metal layer providing a mirror effect.

In response, Appellant presents the following arguments:

BRIEF SUMMARY OF ARGUMENTS

- The Nanbu patent and the Manabe patent do not render obvious claims 15 and 17-20 under 35 U.S.C. §103.
- The Koike patent and the Manabe patent do not render obvious claims 15 and 16 under 35 U.S.C. §103.

The foregoing arguments are explained in more detail below.

A. The Nanbu patent and the Manabe patent do not render obvious claims 15 and 17-20 under 35 U.S.C. §103.

The Office Action of October 16, 2003 asserts that the metal film layer of the Manabe patent as applied to the fishing reel of the Nanbu patent renders the arrangement of claim 15 obvious. Appellant disagrees with this assertion because the metal film layer of the Manabe patent does *not* satisfy the requirement of claim 15.

A-1. The metal film of the Manabe patent does not satisfy the ‘mirroring effect’ requirement of claim 15 of the present application.

Regarding the Manabe patent, the Office Action of the October 16, 2003 on page 4 states:

Manabe teaches applying a ground file-layer *[sic]* and a metal film layer providing a mirror effect formed as a layer on the ground film layer side as explained in column 3 on lines 14-24, 30-43, 67-68, in column 4 on lines 1-3, and in column 5 on lines 1-12.

However, Appellant believes that the metal film of the Manabe patent does *not* provide a mirroring effect as required of the metal film means of claim 15, and therefore does *not* satisfy the requirement of the metal film means as set forth in claim 15.

More specifically, there is no teaching or suggestion in the Manabe patent that the metal film provides a mirroring effect. Although the Manabe patent in column 3, lines 34-38 indicates that the metal film as applied to the base coat by sputtering renders a “metallic luster,” mirroring effect and metallic luster are clearly different. Dictionary meanings of the terms “mirror” and “luster” clearly show the difference.¹ “Mirroring effect” indicates a reflective effect that forms an optical image, as “mirror” is defined as “a polished or smooth surface (as of glass) that forms images by reflection” (bracket in the original),² or a “surface which specularly reflects a large fraction of incident light.”³ On the other hand, “luster” is defined as “[t]he appearance of a surface dependent on reflected light.”⁴ Thus, “*metallic* luster” simply means a metallic appearance that depends on reflected light. There is no suggestion of image-forming quality in the term “metallic luster” as in “mirror.” Thus, the metal film of the Manabe patent does not teach or suggest the properties of the metal film means, i.e., mirroring effect, as required by claim 15.

¹ It is well established that dictionaries provide evidence of a claim term’s “ordinary meaning.” See *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d. 1359, 42 USPQ2d 1658 (Fed. Cir. 2002).

² MERRIAM WEBSTER’S COLLEGIATE DICTIONARY, 10th ed. 743 (1993).

³ MCGRAW-HILL DICTIONARY OF SCIENTIFIC AND TECHNICAL TERMS, 5th ed. 1278 (1993).

⁴ *Id.* at 1180.

A-2. The Manabe patent teaches away from providing a semi transparent metal film layer.

Furthermore, the Manabe patent teaches away from the metal film being semi transparent, while claim 15 clearly requires that the metal film means be semi transparent. In column 6, lines 10-14 of the Manabe patent, it is clearly stated that the thickness of the metal film should be at least 150 Å, because “[i]f the thickness of the metal film is less than 150 Å the coverage of the metal film is insufficient so that the substrate can be seen through the metal film.” Clearly, this statement of the Manabe patent teaches away from forming the metal film semi transparently. Accordingly, Appellant believes that the metal film of the Manabe patent does not satisfy the “semi transparent” requirement of the metal film means of claim 15.

A-3. The thickness of the metal film means of claim 15 is not limited to 50-600 Å

The Office Action of the October 16, 2003 asserts that the specification of the present application defines the thickness of the metal film to be 50-600 Å. Appellant respectfully disagrees with this assertion. As clearly stated on page 6, lines 22-30, the thickness of the metal film is not limited to 50-600 Å. Rather, the thickness that brings out the semi transparent mirroring effect differs depending on the type of metal used as the target and the coarseness of the metallic powder. The reference to the thickness range of 50-600 Å on page 6, line 16 of the specification is given merely as an example of thickness at which aluminum particles of various coarseness can be rendered semi transparent. This reference to the thickness range by no means should be interpreted to limit the scope of claim 15 by limiting the thickness of the metal film means to 50-600 Å.

Furthermore, although the Office Action seems to assume that the metal used in the Manabe patent and that used in the main embodiment of the present application are the same, that is clearly not the case. As discussed above, the metal used in the main embodiment of the present application is aluminum. On the other hand, the Manabe patent discourages use of aluminum because of its poor resistance to weathering and corrosion by attack of chemicals. *See* column 4, line 66 - column 5, line 9.

Therefore, even though the range of thickness of the metal film disclosed in the specification of the present application overlaps with that of the Manabe patent, Appellant believes that the Manabe patent does not teach or suggest a semi transparent metal film, specially since the Manabe patent specifically teaches *away* from forming the metal film semi transparent.

Accordingly, Appellant believes that the Manabe patent does not teach or suggest the film metal means as set forth in claim 15 of the present application.

A-4. The Nanbu patent fails to show or suggest the metal film means as set forth in claim 15 of the present application.

Regarding the Nanbu patent, it discloses a fishing reel having a reel body 2, a handle assembly and a line-winding spool 8 (*see* Figures 1-2), with the reel body 2 having a metal membrane 32 formed by metal plating on the surface of the finger protector 30. The Office Action of October 16, 2003 acknowledges that the Nanbu patent fails to show a ground film-layer formed by a paint coat and a metal film layer providing a mirror effect and being formed semitransparently.

In view of the above comment, Appellant respectfully asserts that the Nanbu patent in combination with the Manabe patent does not render obvious claim 15 of the present application under 35 U.S.C. §103, since neither the Nanbu patent nor the Manabe patent teach or suggest the metal film means of claim 15. Thus, the Koike patent does not provide for the deficiencies of the Manabe patent.

B. The Koike patent and the Manabe patent do not render obvious claims 15 and 17-20 under 35 U.S.C. §103.

The Office Action of October 16, 2003 asserts that the metal film layer of the Manabe patent as applied to the fishing reel of the Koike patent renders the arrangement of claim 15 obvious. Appellant disagrees with this assertion because the metal film layer of the Manabe patent does *not* satisfy the requirement of claim 15.

B-1. The metal film of the Manabe patent does not satisfy requirement of claim 15 of the present application.

As discussed in sections A-1 – A-3 of this brief, the metal film layer of the Manabe patent does not satisfy the requirement of the metal film means of claim 15. Since the Manabe patent has been discussed in sections A-1 – A-3 of this brief, detailed discussions of the Manabe patent will be omitted herein.

B-2. The Koike patent fails to show or suggest the metal film means as set forth in claim 15 of the present application.

Regarding the Koike patent, the Office Action of October 16, 2003 asserts that it discloses a fishing reel having a reel body 2, a handle assembly and a line-winding spool 4 (*see* Figures 1-2), with the spool 4 having the a metallic layer 14 that is formed by a metal plating process (*see* Figures 3). The Office Action acknowledges that the Koike patent fails to show a ground film-layer formed by a paint coat and a metal film layer providing a mirror effect and being formed semitransparently. Thus, the Koike patent cannot cure the deficiency of the Manabe patent.

In view of the above comment, Appellant respectfully asserts that the Koike patent in combination with the Manabe patent does not render obvious claim 15 of the present application under 35 U.S.C. §103, since neither the Koike patent nor the Manabe patent teach or suggest the metal film means of claim 15.

C. Appellant believes that the claims 19-20 are separately patentable.

Appellant believes that claim 19 is separately patentable because it further requires a *protective layer* that is not disclosed or suggest by the prior art. Although the Office Action of October 16, 2003 asserts that the Manabe patent teaches the protective layer of claim 19 in column 3, lines 14-24, 30-43, 67-68, column 4, lines 1-3, and column 5, lines 1-12, these portions of Manabe patent cited in the Office Action are identical with those cited for the discussion of the metal film. In other words, these portions of the Manabe patent pertain to the base coat on which the metal film layer is formed. On the other hand, claim 19 requires that the protective film layer be formed *on* the metal film means, not underneath it. Furthermore, in view of the fact that the Manabe patent requires its metal film layer to have a resistance to weathering

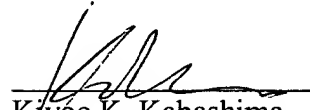
action and corrosion (see column 4, line 66 – column 5, line 9), Appellant believes that the metal film layer of the Manabe patent is designed to be the outermost layer which does not require further protective coating. Thus, the Manabe patent does not teach or suggest the protective film layer, which is to be formed *on* the metal film means. Thus, Appellant believes that claim 19 is patentable independently of claim 15.

Appellant believes that claim 20 is separately patentable because it further requires an *anodized film layer* that is not disclosed or suggest by the prior art. Although the Office Action of October 16, 2003 asserts that paragraphs 21-24 of the Nanbu patent teach the anodized film layer of claim 20, the portions of Nanbu patent cited in the Office Action concern plating of a resin-made member with metals such as nickel and copper, *not* formation of anodized layer as required by claim 20 and discussed on page 5, lines 23-29 of the present application. Therefore, the Nanbu patent does not teach or suggest the anodized film layer of claim 20. Thus, Appellant believes that claim 20 is patentable independently of claim 15.

9. Conclusion

In view of the above analysis of claims 15-20, Appellant believes that the claims 15 and 17-20 are not rendered obvious by Japanese Patent Application Publication 2001-017040 to Nanbu Kazuya and U.S. Patent No. 4,369,225 to Manabe et al. under 35 U.S.C. §103. Also, the claims 15-16 are not rendered obvious by the Japanese Patent Application Publication 11-206284 to Koike Mamoru in view of U.S. Patent No. 4,369,225 to Manabe et al. Thus, Appellant respectfully requests that the rejections of claims 15-20 be reversed, and that claims 15-20 be allowed. If there are any questions regarding this Brief, please feel free to contact the undersigned.

Respectfully submitted,



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Dated: Mar 12, 2004

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APPENDIX A

COPY OF CLAIMS ON APPEAL

15. (Original) A fishing reel, comprising:

a reel body, including

a component body,

a ground film-layer formed by a paint coat on an obverse-layer side of said

component body, and

metal film means for providing a mirroring effect, said metal film means being

formed semitransparently on an obverse-layer side of said ground film-layer;

a handle assembly disposed on a side of said reel body; and

a line-winding spool removably and reattachably fitted to said reel body.

16. (Original) The fishing reel as set forth in claim 15, wherein

said fishing reel is a spinning reel and further comprises a rotor rotatably fitted to said reel body, and

said spool can move reciprocatingly with respect to said reel body.

17. (Original) The fishing reel as set forth in claim 15, wherein

said fishing reel is a dual bearing reel, and

said spool is rotatably fitted to said reel body.

18. (Original) The fishing reel as set forth in claim 15, wherein

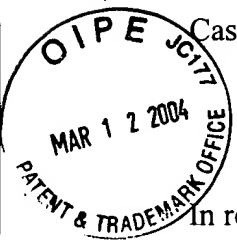
said metal film means is formed by metal vapor deposition, and contains any one of chrome, nickel, zinc, magnesium, aluminum, a stainless steel alloy, and titanium.

19. (Original) The fishing reel as set forth in claim 15, further comprising a protective film layer formed by a clear paint coat on an obverse-layer side of said metal film means.

20. (Original) The fishing reel as set forth in claim 15, further comprising an anodized film layer formed in between said component body and ground film-layer by anodizing,

said component body of said reel being formed from at least one of aluminum alloy and magnesium alloy.

AF/3654
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THE ASSISTANT COMMISSIONER OF PATENTS
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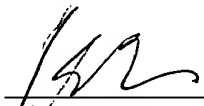
Sir:

Transmitted herewith in triplicate is Appellant's Brief on Appeal for the above-identified application. Also a check in the amount of \$330.00 is attached to cover the Appeal fee (37 CFR 1.17(c)).

[X] The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No.: 50-1836. A duplicate copy of this sheet is attached.

[X] Any additional excess claim fees under 37 CFR 1.16.

[X] Any additional patent application processing fees under 37 CFR 1.17.


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